

### **REMARKS**

Claims 1-10 and 12-19 are pending in the present application after the addition of claims 16-19. Among the pending claims, claims 1-10 and 12-14 have been withdrawn, and claim 15 has been rejected. Claim 15 has been amended herein. In view of the foregoing amendments and the following remarks, it is respectfully submitted that pending claims 15-19 are in allowable condition, and reconsideration is respectfully requested.

#### **Rejection of Claim 15 under 35 U.S.C. § 103(a)**

Claim 15 stands rejected under 35 U.S.C. § 103(a) as obvious over US Patent Application Publication No. 2002/0130906 (Miyaki) in view of US Patent No. 6,640,185 (Yokota) and further in view of U.S. Patent Application Publication No. 2003/0085910 (Noble) and U.S. Patent Application Publication No. 2002/0145632 (Shmueli). Applicants submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 15 has been amended to explicitly recite the following:

15. (Currently Amended) A driver information device comprising:  
a map display, special objects being represented on the map display by special object symbols, a common indicator symbol in the map display indicating a presence of corresponding multiple special objects one of (a) in one location and (b) within a preselected radius of a location, a selection of the

common indicator symbol enabling a display of a selection menu containing information about the corresponding multiple special objects, wherein the selection menu is displayed on the map display;

wherein during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu.

In support of the obviousness rejection, the Examiner asserts the following arguments for combining the selected teachings of the applied references: a) “Miyaki teaches superimposing a menu on the map (paragraph 0045)”; b) “Yokota suggests displaying the special objects symbols in a selectable menu 120-122 (Fig. 12B)”; c) “Noble teaches displaying the indicator symbol 104 (Fig. 2) at the same location on the map (Fig. 2)”; and d) “Shmueli teaches displaying a selection menu 88-92 (Fig. 6) with a symbol 86 (Fig. 6) displayable at the same location on the display and embedded in the selection menu (Fig. 6).” Based on these assertions, the Examiner summarily concludes that “[i]t would have been obvious . . . to display the menu of Miyaki as selectable menu as taught by Yokota and to display the menu embedding the symbol at the same location on the map as taught by the combined teachings of Noble and Shmueli in order to allow the user to obtain more information on an interested point of interest at the area the point of interest is located.” Applicants will address the Examiner’s assertions in detail below.

Initially, Applicants note that the Examiner’s stated rationale for making the asserted combination of the specific teachings of the applied references is woefully inadequate to support the asserted combination. The only stated rationale supporting the Examiner’s asserted combination is that the combination would “allow the user to obtain more information on an interested point of interest at the area the point of interest is located.” However, even if one assumes that a person of ordinary skill in the art would be motivated by the goal of “allowing the user to obtain more information on an interested point of interest at the area the point of interest is located,” with which assumption Applicants do not agree, it is simply unreasonable to suggest that one of ordinary skill in the art, without knowing anything

about Applicants' claimed invention, would actually be motivated to specifically pick out the selected parts of each of the applied references and combine the selected parts in the exact manner asserted by the Examiner. In fact, the Examiner does not even state why one of ordinary skill in the art would initially arrive at the "combined teaching of Noble and Shmueli," which is further combined with other specific teachings of Miyaki and Yokota. Applicants note that the Examiner's obviousness rationale is a classic example of an "obvious-to-try" rationale, which is insufficient to support a *prima facie* obviousness: the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). With respect to the subjective "obvious to try" standard, the cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), clearly indicate that the Examiner's generalized assertions that it would have been obvious to combine or modify the references relied upon do not properly support an obviousness rejection. In particular, the Court in the case of In re Fine stated: "Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to **pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**" In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . . Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention]. In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted).

Applicants note that the Examiner has offered no evidence whatsoever of actual suggestion in the applied prior art to make the asserted modification, but only conclusory hindsight, reconstruction and speculation, which the Court of Appeals for the Federal Circuit has indicated does not constitute evidence that will support a proper obviousness finding. In

fact, Applicants will address the overall teachings of the applied references in detail below, and show that the overall teachings actually negate the Examiner's obviousness conclusion. (See MPEP 2141.02 VI, noting that "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention"; see also MPEP 2143.01 V & VI, noting that obviousness is negated if the proposed modification renders the prior art being modified unsatisfactory for its original intended purpose or changes the principle of operation of the prior art being modified).

With respect to the teachings of Miyaki, Applicants note that Miyaki actually teaches away from the overall combination asserted by the Examiner, i.e., Miyaki teaches away from **showing the common indicator symbol at the same place in the map and embedded in the selection menu**. Miyaki shows two different specific embodiments: in the first specific embodiment (paragraph 0045), upon a selection of the multiple-icon icon 51, this icon is substituted by the individual POI icons, i.e., in this specific embodiment no menu is displayed at all; in the second specific embodiment, only a list of POI's having assigned supplementary data is displayed, i.e., no multiple-icon icon is displayed. Therefore, by teaching that one should fade out the multiple-icons during an operator selection, Miyaki clearly teaches away from creating a spatial relationship between any sort of a displayed list and a simultaneously displayed common indicator symbol for multiple places of interest on the map, i.e., the overall teachings of Miyaki clearly negate the idea that one of ordinary skill in the art would actually incorporate selective teachings of Miyaki to arrive at an arrangement in which "during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu."

Yokota also teaches away from the Examiner's asserted combination in an even more fundamental way: in Yokota, a selection menu is only shown instead of a map. Accordingly, the idea that one of ordinary skill in the art would actually incorporate the teachings of Yokota selectively to arrive at an arrangement in which "during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu," is

completely negated by the overall teachings of Yokota.

With respect to the teachings of Noble and Shmueli, the Examiner implicitly assumes that one of ordinary skill in the art would selectively combine the teachings of Noble and Shmueli to arrive at “the menu embedding the symbol at the same location on the map.” Although there is no apparent reason why anyone would make this selective combination, even if one assumed that there was some motivation to combine the teachings of Noble and Shmueli, the asserted combination would not result in the combined teaching alleged by the Examiner, let alone provide a component teaching for a rationale combination to arrive at the claimed invention. While the Examiner contends that Noble teaches displaying the indicator symbol 104, the specification of Noble clearly indicates that 104 is a map display region. (Paragraph [0042]). In addition, while Shmueli discloses a selection menu in which a selection field “launch button” can be expanded by additional selection fields, there is simply no suggestion of applying this expansion to a map display, let alone any suggestion of displaying a common indicator symbol that continues to be represented in a map display. Accordingly, there is simply no support for the Examiner’s assertion that the combined teachings of Noble and Shmueli would result in display of “the menu embedding the symbol at the same location on the map.”

While the Examiner has assembled a combination of many great elements disclosed in the applied references of Miyaki, Yokota, Noble and Shmueli, there is simply no objective suggestion to make the specific combination asserted by the Examiner, and the actual overall teachings of the applied references negate any suggestion for combining the selected teachings in the manner asserted by the Examiner. In any case, even if there were some motivation to combine the teachings of the applied references, the subject matter of the present invention is fundamentally different from the combined overall teachings of Miyaki, Yokota, Nobel and Shmueli: while Applicants’ claimed invention involves a common indicator symbol (corresponding to multiple special objects) shown on a map, which common indicator symbol, upon selection, is simultaneously included in a selection menu superimposed on the map and continues to be displayed at the same spot on the map even during the display of the selection menu, the overall teachings of Miyaki, Yokota, Nobel and

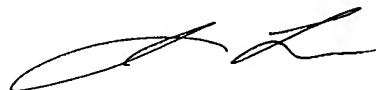
Shmueli simply do not suggest the simultaneous display of a selection menu superimposed on a map, a common indicator symbol included in the selection menu, and the continued positioning of the common indicator symbol at the same location on the map both prior to, and after, the selection of the common indicator symbol.

For the foregoing reasons, the overall teachings of Miyaki, Yokota, Noble and Shmueli fails to teach or suggest the subject matter of claim 15. Accordingly, Applicants respectfully submit that claim 15 and its dependent claims 16-19 are not rendered obvious by the applied references.

### **CONCLUSION**

In view of the above amendments and remarks, it is respectfully submitted that pending claim 15 and its dependent claims 16-19 are in allowable condition. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully Submitted,  
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